

### **REMARKS**

This Amendment is in response to the December 7, 2006 Office Action. The Examiner objected to the abstract of the disclosure. The Examiner also rejected claims 1-3 and 6-8 under 35 U.S.C. 102(b) as being anticipated by Jensen et al. (US Patent No. 4,873,193). Next, the Examiner rejected claims 1-3, 6, and 8 under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (US Patent No. 5,690,246) in view of Jensen et al. Finally, the Examiner rejected claims 1 and 5 under 35 U.S.C. 103(a) as being unpatentable over McKee (US Patent No. 4,860,899) in view of Mangini et al. (U.S. Patent No. 5,046,609). The Applicant traverses the rejections and submits the following:

#### **Objections**

The Examiner objected to the abstract of the disclosure. By the above amendment, Applicant has amended the brief description of figure 4, and respectfully submits that the objection is overcome and should be withdrawn.

#### **Rejections under 35 U.S.C. §102**

The Examiner rejected claims 1-3 and 6-8 under 35 U.S.C. 102(b) as anticipated by Jensen et al. (US Patent No. 4,873,193). Claim 1 of the present application recites, “a substantially opaque container and a substantially opaque lid that engages the container wherein the container and lid resemble a pharmaceutical package; at least one surprise item disposed in the container; and written material that accompanies the container, wherein the written material has an interplay with the at least one surprise item in the container.” The Examiner states that a substantially opaque container ... is disclosed in Jensen et al... containing a “gift” item in as

much as is set forth on page 7, second paragraph of the present specification. Applicant respectfully disagrees.

The Jensen et al. patent discloses a substantially translucent inner container or specimen vial for holding *biological fluid evidence* (col. 4, lines 20, 21, 41-43, & 49-54), which is placed within the opaque outer container. Applicant disagrees that the “inner container 28 and corresponding lid 30,” as well as the fluid biological evidence contained therein and disclosed in Jensen et al., is a “surprise item” as recited in claim 1 of the present application within the meaning of the present specification. The user, who seals the biological fluid evidence inside the inner container and then places the inner container inside of the outer container, knows the nature of the contents therein. Additionally, the recipient of the apparatus of Jensen et al. likewise knows that the contents of the apparatus he is receiving is biological fluid evidence for testing. As such, the fact that both the user and recipient of the apparatus know that the contents are biological fluid evidence negates any element of “surprise” as to the apparatus’ contents and precludes that container from being a “surprise item” as disclosed in Claim 1.

Furthermore, the inner container or specimen vial of Jensen et al. is substantially “transparent or translucent” (col. 4, lines 49-50) such that the intended recipient can readily see the level of fluid contained therein. In contrast, the container in Claim 1 of the present application is substantially opaque, such that the recipient cannot see the contents thereof, nor will he know the contents thereof, until the container is actually opened.

Similarly, just as the disclosure in Jensen et al. does not meet the, “surprise item,” limitation of Claim 1, it thus also does not meet the “written material that accompanies the container, wherein the written material has an interplay with the at least one surprise item in the container” limitation of Claim 1. Therefore, even if the container of Jensen et al. would have a

label attached to it on which written material may be printed, because there is no “surprise item” element as previously discussed, there cannot consequently be “written material that accompanies the container, wherein the written material has an interplay with the at least one surprise item in the container.” Therefore, Jensen et. al does not anticipate Claim 1.

As such, Jensen et al. does not anticipate independent Claim 1 of the present application because Jensen does not disclose each and every limitation of Claim 1. Consequently, claims 2-3 and 6-8, which depend from claim 1 and incorporate all of the limitations of claim 1, are also not anticipated by Jensen et al.

**Rejections under 35 U.S.C. §103(a)**

**Claims 1-3, 6, & 8**

The Examiner rejected claims 1-3, 6, and 8 under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (US Patent No. 5,690,246) in view of Jensen et al. The Examiner states that Anderson et al. discloses a container “for containing a ‘gift’ item in as much as is claimed and disclosed” in the present invention. Applicant respectfully disagrees. The present invention does not merely disclose a container for holding a “gift,” rather a container for holding a “surprise item” which is substantially different than merely a “gift.” For a “surprise item,” the recipient of the container has no prior knowledge what the item enclosed therein is, until he actually sees the item, whereas with a “gift” the recipient may know what it is he is receiving prior to seeing it or opening the container it came in. Accordingly, the combination of Anderson and Jensen still fails to meet all of the limitations of the claim.

Furthermore, as discussed previously, the present invention requires that the opaque container has at least one “surprise item” disposed therein. Anderson et al. discloses a

tamperproof security container for holding a sample bottle, such that it is not possible to interfere with the contents of the sample bottle, without it being readily apparent, once the container has been closed. The disclosure of Andersen et al. further states that its application is for biological samples such as urine. As such, the user and recipient of such a container as disclosed in Anderson et al. will both know the contents of the container, or the contents of the sample bottle contained therein, which does not constitute a “surprise” item as required by Claim 1. Furthermore, the addition of written information on the container of Anderson et al. still does nothing to meet the “surprise item” limitation of Claim 1.

#### **Claims 1 & 5**

The Examiner also rejected claims 1 and 5 under 35 U.S.C. 103(a) as being unpatentable over McKee (US Patent No. 4,860,899) in view of Mangini et al. (U.S. Patent No. 5,046,609). The references do not contain any suggestion that they be combined or that they be combined in the manner suggested by the Examiner. And even if combined, the combination still would not supply all of the claim limitations. As argued previously, the user and the recipient of the envelope disclosed in McKee both know that the contents of the envelope are medications, regardless of whether the envelope in question is actually a bag, an envelope, or a bottle, or whether it is transparent or opaque, thus negating any element of “surprise” that is required in the “surprise item” limitation to Claim 1 in the present application.

Also, McKee teaches away from the suggested combination. McKee specifically states that one side of the envelope should be transparent to allow visual inspection of the medications contained therein (col. 4, lines 63-68; col. 6, lines 59-66). If the packets in McKee were opaque bottles, the user or recipient in McKee would not have the ability to check the medication

contained therein against the contents printed on the outside of the container without first opening the container, which is completely contrary to the McKee disclosure. Therefore, the proposed combination would also result in an inoperative combination.

***Conclusion***

For the foregoing reasons, Applicant respectfully submits that the pending claims (1-3 and 5-8) are in condition for allowance and request that the Examiner issue a notice to that effect. The Office is authorized to charge all fees, if any, associated with this Amendment to Deposit Account No. 13-0019.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Victoria Friedman", is written over a horizontal line.

Victoria Friedman

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